

Serial No. 09/773,263  
Page 9 of 15

### REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed September 21, 2005. In the Office Action, the Examiner notes that claims 1-30 are pending; claims 1-25, 29 and 30 are rejected; and claims 26-28 are withdrawn from consideration. By this response, Applicants have amended claims 1, 5, 14 and 30.

In view of the above amendments and the following discussion, Applicants submit that the claims pending in the application are not anticipated and are non-obvious under the respective provisions of 35 U.S.C. §102 and §103. Thus, Applicants believe that the application is in condition for allowance.

It is to be understood that Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

#### Amendments to the Claims

By this response, Applicants have amended claims 1, 5, 14 and 30. The amendments to the claims are fully supported by the Specification, Drawings and Claims as originally filed.

For example, the amendments to Claims 1 and 14 are supported at least by originally filed Claim 5, and page 6, lines 8-9, of the Specification. The amendments to Claims 5 and 30 are supported at least by page 6, lines 7-8 and lines 27-30, of the Specification.

Thus, no new matter has been added and the Examiner is respectfully requested to enter the amendments to the claims.

#### Restriction of Claims and Election of Species and Subspecies

The Examiner has restricted the claims into two species, corresponding respectively to a digital and an analog implementation of an ad insertion module. Furthermore, the Examiner has withdrawn claims 26-28 from consideration as allegedly belonging to a non-elected invention. The Applicants respectfully disagree with the characterization of claims 26-28.

Serial No. 09/773,263  
Page 10 of 15

In particular, the Examiner alleges:

"Newly submitted claims 26-28 are directed to an invention that is independent or distinct from the invention originally claimed. In particular, the originally presented claims were directed towards the generic system (Figure 1) and the species corresponding to the digital implementation of the ad insertion module (Figure 2A). Newly added claims 26-28 are directed towards the species corresponding to the analog implementation of the ad insertion module (Figure 2B).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-28 are withdrawn from consideration as being directed to a non-elected invention."

Thus, the Examiner alleges that claims 26-28 belong to the analog implementation, and as such are directed to a non-elected invention. However, the Applicants disagree. Claim 26, as previously presented, clearly recites: "a network headend for transmitting at least one digital information stream to a plurality of users," and "a distribution network for transmitting the digital information stream," and "a plurality of terminal devices interfaced to the distribution network for receiving the digital information stream." Thus, claim 26, as previously presented, clearly belongs to the digital implementation.

Additionally, other previously presented language of claim 26 clearly belongs to the digital implementation. For example, previously presented claim 26 recites "of advertisements comprising a continuous stream of I-frames for a predetermined amount of time at the beginning and end of each advertisement." The recited I-frames belong to the digital implementation, as described in the Specification at page 9, lines 10-23.

Therefore, the Examiner is respectfully requested to repeal the withdrawal from consideration of claims 26-28 because these claims belong to the species the Examiner has acknowledged is being examined.

Furthermore, the Applicants traverse the Examiner's restriction of the claims into two species. It would not present an undue burden upon the Examiner to examine both the digital and analog implementations at the same time, as each implementation shares many features of the invention. Indeed, the Specification recites as much (emphasis added below):

Serial No. 09/773,263  
Page 11 of 15

"FIG. 2B illustrates a variation of the ad insertion module 46 that includes many of the same elements illustrated in FIG. 2A, as is preferably employed in an analog embodiment of the present invention." (page 8, lines 17-19)

Thus, the Examiner is respectfully requested to withdraw the restriction requirement.

**35 U.S.C. §102 Rejection of Claims 1, 14 and 29**

The Examiner has rejected claims 1, 14 and 29 under 35 U.S.C. §102(e) as being anticipated by Sitnik (U.S. Patent 6,160,570, hereinafter "Sitnik). Applicants respectfully traverse the rejection.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. The Sitnik reference fails to disclose each and every element of claim 1, as arranged in the claim.

Specifically, the Sitnik reference fails to teach or suggest at least the "said terminal processor being further programmed to provide a prompt to said user designated to receive said additional information, said prompt being embedded in said information stream" as recited in the claim.

The Sitnik reference discloses a digital television system in which "[a] controller receives video data corresponding to at least two alternative images" (Abstract). The Sitnik reference discloses (emphasis added below):

"Following step S301, processing proceeds to step S302, in which the user profile is stored in a memory, such as the non-volatile storage 22. Thereafter, step S303 receives, from the demultiplexer 10, data packets containing alternative images for display within a video sequence, and decodes video data in these packets if necessary. Next, step S304 selects one of the alternative images for display based on information in the user profile and based on information in the data packet corresponding to the selected image. More specifically, the data packets, received in step S304 containing alternative images, also contain information which can be correlated to parameters in the user's profile. Step S304, therefore, decomposes received data packets in order to obtain this information, and selects an alternative image in a data packet that has information which correlates to parameters in the user's profile." (column 8, lines 19-34)

The Sitnik reference also discloses (emphasis added below):

"Once step S304 selects an image, processing proceeds to step S305. Step S305 determines if there is any audio information associated with the selected image. For example, in the case that the selected image

Serial No. 09/773,263  
Page 12 of 15

is an image used in product placement, it is unlikely that there is corresponding audio information associated with the selected image. Accordingly, in such a case, processing proceeds to step S306. In step S306, the selected image is output to display processor 12, together with information concerning how and when in a video sequence the selected image is to be displayed. Thereafter, the display processor 12 superimposes data for the selected image in the data stream and displays the video sequence, including the selected image, on the display screen 14." (column 9, lines 10-23)

Thus, the Sitnik reference selects an alternative image for display, and possibly audio information associated with the selected image, and then outputs the selected image to a display processor. However, the Sitnik reference does not teach or suggest providing a prompt to a user designated to receive the alternative image or the associated audio information. Moreover, the Sitnik reference also does not teach or suggest such a prompt being embedded in an information stream.

Therefore, the Sitnik reference fails to teach or suggest each and every element as arranged in claim 1.

As such, Applicants submit that claim 1 is not anticipated and fully satisfies the requirements of 35 U.S.C. §102 and is patentable thereunder. Moreover, claim 14 contains substantially similar limitations as those discussed above in regards to claim 1. Therefore, claim 14 also is not anticipated and fully satisfies the requirements of 35 U.S.C. §102 and is patentable thereunder. Furthermore claim 29 is depends directly from claim 1 and recites additional limitations thereof, and for at least the same reasons discussed above with respect to claim 1, claim 29 also is not anticipated and fully satisfies the requirements of 35 U.S.C. §102 and is patentable thereunder.

Therefore, Applicants respectfully request that the Examiner's rejection of claims 1, 14 and 29 be withdrawn.

#### **35 U.S.C. §102 Rejection of Claims 1-6, 14-19, 25 and 30**

The Examiner has rejected claims 1-6, 14-19, 25 and 30 under 35 U.S.C. §102(b) as being anticipated by Maillard et al. (EP 963 119 A1, hereinafter "Maillard"). The rejection is respectfully traversed.

The Maillard reference also fails to disclose each and every element of the claimed invention, as arranged in claim 1.

Serial No. 09/773,263  
Page 13 of 15

Specifically, the Maillard reference fails to teach or suggest at least "said terminal processor being further programmed to provide a prompt to said user designated to receive said additional information, said prompt being embedded in said information stream" as recited in the claim.

The Maillard reference discloses a plurality of filters associated with an interactive application (see abstract). Specifically, the Maillard reference discloses (emphasis added below):

"The remote control is a usual remote control generally delivered with a TV set with a special key or a plurality of keys dedicated to Interactivity. During an interactive program or clip, a logotype or a message appears on the display which invites the viewer to participate and to react. By pressing one or more of these special keys, the viewer has access to the interactivity function proposed. This interactivity function is for instance a vote, a game choice, a brochure command, a survey, etc." (paragraph 45)

Thus, the Maillard reference discloses displaying a logotype or a message during an interactive program or clip, and providing access to an interactivity function to a viewer if the viewer presses one or more special keys. However, the Maillard reference does not teach or suggest that the logotype or message is embedded in the information stream containing the interactive program or clip.

The Examiner alleges:

"Claim 30 is rejected wherein the "prompt is embedded in said information stream" as distributed as part of the interactive application (Figure 3)"  
(page 7 of the 9/21/2005 Office Action)

Thus, the Examiner alleges that Figure 3 of the Maillard reference discloses the prompt as embedded in the information stream. However, the Applicants respectfully disagree.

The Maillard reference discloses:

"Figure 3 shows the filter format and the filtering process in the case of one filter and one interactive application." (Paragraph 63)

Thus, the Maillard reference discloses Figure 3 shows the filter format and the filtering process, but not a prompt to a user indicating the availability of additional information. Furthermore, explicit examination of Figure 3 by the Applicants reveals no such prompt contained in Figure 3.

Serial No. 09/773,263  
Page 14 of 15

Thus, the Maillard reference fails to teach or suggest each and every element as arranged in claim 1.

As such, claim 1 is not anticipated by Maillard and is patentable under 35 U.S.C. §102. Moreover, Claim 14 includes relevant limitations similar to those discussed above in regards to Claim 1. Therefore Claim 14 is also not anticipated by Maillard and is patentable under 35 U.S.C. §102. Furthermore, claims 2-6, 15-19, 25 and 30 depend, either directly or indirectly, from independent claims 1 and 14 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, these dependent claims are also not anticipated by Maillard and are patentable under 35 U.S.C. §102.

Therefore, Applicants respectfully request that the Examiner's rejection of claims 1-6, 14-19, 25 and 30 be withdrawn.

**35 U.S.C. §103(a) Rejection of Claims 7-12 and 20-23**

The Examiner has rejected claims 7-12 and 20-23 under 35 U.S.C. §103(a) as being unpatentable over Maillard in view of Wachob (U.S. Patent No. 5,155,591, hereinafter "Wachob"). Applicants respectfully traverse the rejection.

Claims 7-12 and 20-23 depend directly or indirectly from independent claims 1 and 14. Moreover, for at least the reasons discussed above, the Maillard reference fails to teach or suggest Applicants' invention as recited in claims 1 and 14. Accordingly, any attempted combination of the Maillard reference with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. As such, Applicants submit that dependent claims 7-12 and 20-23 are not obvious and are patentable under 35 U.S.C. §103.

Therefore, Applicants respectfully request that the Examiner's rejection of claims 7-12 and 20-23 be withdrawn.

**35 U.S.C. §103(a) Rejection of Claims 13 and 24**

The Examiner has rejected claims 13 and 24 as being obvious and unpatentable over Wachob in view of Bryant et al. (U. S. Patent No. 5,652,615, hereinafter "Bryant") under the provisions of 35 U.S.C. §103(a). Applicants respectfully traverse the rejection.

Serial No. 09/773,263  
Page 15 of 15

Claims 13 and 24 depend directly or indirectly from independent claims 1 and 14. Moreover, for at least the reasons discussed above, the Maillard reference fails to teach or suggest Applicants' invention as recited in claims 1 and 14. Accordingly, any attempted combination of the Maillard reference with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. As such, Applicants submit that dependent claims 7-12 and 20-23 are not obvious and are patentable under 35 U.S.C. §103.

Therefore, Applicants respectfully request that the Examiner's rejection of claims 13 and 24 be withdrawn.

#### CONCLUSION

Thus, Applicants submit that all the claims pending in the application are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Stephen Guzzi, at (732) 383-1405, or Eamon J. Wall, Esq., at (732) 530-9404, so appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

12/21/05



Eamon J. Wall, Attorney  
Reg. No. 39,414  
(732) 530-9404

Patterson & Sheridan, LLP  
Attorneys at Law  
595 Shrewsbury Avenue, Suite 100  
Shrewsbury, New Jersey 07702

422535\_1.DOC